



Atty. Dkt. No. 040302-0385

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Takashi ODA et al.

Title: RESIN COMPOSITION, FILLER, AND METHOD OF PRODUCING  
RESIN COMPOSITION

Appl. No.: 10/790,529

Filing Date: 3/2/2004

Examiner: Marc A. Patterson

Art Unit: 1772

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated April 3, 2006, Applicants hereby elect the claims of Group I, claims 1-13, for prosecution in the subject application. This election is made with traverse, insofar as explained below.

Neither Inventions I and II nor Inventions I and IV are properly restrictable. Contrary to the Office Action, the combination of claim 1 (thermoplastic resin + compound of claim 14) does clearly require the particulars of the subcombination (compound of claim 14, which reads on the recited compound irrespective of whether the preamble recites "filler" or "compound"). Thus, the two-way distinctness test of MPEP § 806.05(c) is not satisfied. Similarly, independent claim 26 (Invention IV) claims an automotive part made from the composition defined by claim 1. These are not *mutually distinct* species, inasmuch as claim 26 can just as easily be written to depend from claim 1. Therefore, reconsideration of the restriction requirement to this extent, and examination of Inventions I, II and IV, are respectfully requested, since all claims require the particulars of the subcombination of Invention II.

In addition, according to MPEP §821.04, "Process claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance." See also *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995). Thus, upon an indication of allowability of the elected product claims (and those not properly restrictable therefrom), Applicants respectfully request rejoinder of the method claims of Inventions III and V.

Applicant, of course, reserves the right to file a divisional application covering the subject matter of any of the non-elected claims.

Receipt of the initial Office Action on the merits is awaited.

Respectfully submitted,

Date May 3, 2006

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